

REMARKS

Claims 11-14 and 16-21 are currently pending in the application; Claims 11, 17 and 18 are independent. Applicants respectfully request reconsideration of the pending claims in light of the foregoing amendment and the following remarks.

The Examiner has rejected Claims 11-14 and 16-21 under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Examiner has alleged that the specification fails to provide proper support for the following limitations added for responding to the previous final Office Action: a first radial groove for receiving a **securing element** and free extension for coupling a **rotational tool**.

Applicants respectfully disagree with the Examiner. Applicants respectfully submit that the present application adequately describes an adjacent radial groove for placing therein a securing element (*see*, Page 4, Line 16 of the specification as originally filed) and a rotational tool can be directly applied at the free extension (*see*, Page 4, Lines 17-18 of the specification as originally filed). Thus, the above claim limitations are fully supported by the specification. Accordingly, the rejection is overcome, and withdrawal thereof is respectfully requested.

The Examiner has rejected Claims 11, 13, 14 and 16-21 under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent Application Publication No. 2004/0096804 to Vogt et al., (hereinafter “Vogt”) in view of U.S. Patent Application Publication No. 2004/0101808 to Porter et al., (hereinafter “Porter”). Applicants respectfully traverse the rejection for at least the following reasons.

Independent Claim 11 recites a transfer part for holding a dental implant. The transfer part includes, *inter alia*, a free extension at one end of the transfer part for coupling a rotational tool and a first radial groove adjacent to the free extension for receiving a securing

element, a clamping portion at the other end of the transfer part for the clamping connection of the transfer part to the dental implant, and a force transmission element for securing the clamping connection against rotation. The clamping portion includes a second radial groove, into which a clamp ring is insertable to engage with the dental implant. The dental implant includes an undercut positioned correspondingly to the second radial groove of the clamping portion of the transfer part and dimensioned suitably to provide together with the second radial groove a receiving means for clampingly receiving the clamp ring.

Independent Claims 17 and 18 recite at least the above features.

Vogt discloses a combination of a dental implant (1), an adapter (3) and a transfer cap (2). The adapter engages the transfer cap, which in turn engages the dental implant. Specifically, as illustrated in Figs. 3A-3C of Vogt, the adapter has a driving section (30) for fitting into the dental implant, a holding section (31) for engaging the transfer tap, and a plug-type extension (33) for fitting into a coupling piece (rotational tool) used in connection with a screw turning instrument.

Vogt further discloses that the extension (33) has an annular groove (331) for receiving a retaining ring (332) and a non-rotationally symmetrical outer contour (330) for form-fit attachment of the coupling piece (*see*, Paragraph [0088], Lines 18-23 of Vogt).

Once the dental implant, the adapter and the transfer cap are assembled, as shown in Fig. 5B of Vogt, the adapter is coupled with the cap through a press fitting or snap connection, and the transfer cap holds the dental implant through the engagement between an elastic lip (26) of the cap and an implant shoulder (11) of the dental implant. In addition, the driving section (30) of the adapter is placed in a cavity (17) of the dental implant, and the extension (33) of the adapter is

disposed outside of the dental implant for engaging a rotational tool during the conveyance of the dental implant.

In the Office Action, the Examiner has apparently interpreted the driving section (30) of the adapter as a disclosure of the free extension (recited in Claims 11, 17 and 18) for coupling a rotational tool, and the Examiner has further apparently interpreted the extension (33) of the adapter as a disclosure of the clamping portion (recited in Claims 11, 17 and 18) for connecting the transfer part to the dental implant.

Applicants respectfully disagree.

Initially, as explicitly disclosed by Vogt, the driving section (30) is disposed within the cavity of the dental implant and the extension (33) is disposed outside of the dental implant for coupling a rotational tool. Therefore, the Examiner's interpretation of the driving section and the extension of Vogt is fundamentally divorced from the teaching of Vogt. As a matter of fact, the Examiner has interpreted the structure and function of the driving section and the extension, in a backwards manner, without providing any reasoning for prompting a person of ordinary skill in the art to do so.

It has been established by the court that "a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention" *See, W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 312-313 (Fed. Cir. 1983).

In the instant case, the teaching of Vogt requires the transfer cap (2) to implement the connection and fixation between the adapter and the dental implant. Specifically, as shown in Figs.5B and 5C of Vogt, the mechanical connection and force transmission between the adapter and the transfer cap is implemented through a press fitting or snap connection therebetween (*see*,

Col. 6, Paragraph [0094], Lines 4-6 of Vogt: “and the holding section 31 of the adapter 3 is gripped with defined frictional connection by the cylinder portion 200 of the transfer cap 2.”).

Furthermore, the transfer cap (2) has a contact surface (25) complementary to the implant shoulder (11), and an elastic lip (26) engaging over the shoulder edge (110) (*see*, Abstract of Vogt). Thus, the adapter (3), *per se*, is not capable of holding the dental implant (1), but rather the dental implant is held by the transfer cap.

In contrast, the claimed invention contemplates a one-piece transfer part for holding a dental implant, which holds the dental implant by the engagement between the radial groove of the transfer part and the clamp ring disposed within the transfer part as well as the engagement between the undercut within the dental implant and a part of the clamp ring operatively disposed within the undercut.

Therefore, considering the totality of the teaching provided by Vogt (an extension 33 disposed outside of the dental implant for coupling a rotational tool, a driving section disposed inside of the dental implant, and a transfer cap for holding the dental implant), a person of ordinary skill in the art would not consider the extension (and its adjacent groove) a clamping portion for engaging the dental implant.

Furthermore, Applicants submit that the Examiner’s hypothetical modification of Vogt is an application of impermissible hindsight. Concerning hindsight in determining patentability of an invention, Applicants note in this regard that MPEP § 2141.01 states that:

The requirement "at the time the invention was made" is to avoid impermissible hindsight. See MPEP § 2145, paragraph X.A. for a discussion of rebutting applicants' arguments that a rejection is based on hindsight.

"It is difficult but necessary that the decision maker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

As discussed above, Vogt does not teach or suggest a clamping portion of the transfer part for connecting the transfer part to the dental implant, which includes a second radial groove, into which a clamp ring is insertable to engage with the dental implant. Applicants submit that the Examiner's hypothetical modification of Vogt is not warranted by the rules of M.P.E.P.

In addition, the Examiner has alleged that Vogt teaches a ring (332) in its non-assembled state having a gap (*see*, Page 3, Line 7 of Paragraph 3 of the Office Action), and that Vogt teaches an undercut (301) formed within the dental implant (*see*, Page 6, Lines 4-5 of the Office Action). Applicants respectfully disagree.

Vogt only teaches that the extension has "an annular groove (331) for receiving a retaining ring (332), preferably in the form of an O-ring" (*see*, Paragraph [0088], Lines 18-19 of Vogt). Vogt does not teach or suggest that the retaining ring, in its non-assembled state, has a gap. In contrast, the claimed invention contemplates a clamp ring provided with a gap to simplify the assembly.

Vogt also teaches that, “the outer contour 300 runs out as a beveled surface 301 at the transition to the holding section 31” and “the holding section 31 is formed by a cylindrical portion which starts at the beveled surface 301” (*see*, Paragraph [0088], Lines 10-13 of Vogt). Thus, Vogt only teaches that the adapter has a beveled surface. Nowhere does Vogt teach an undercut (301) formed within the dental implant. Applicants respectfully submit that it is improper to allege the teaching of an undercut formed within the dental implant merely by the disclosure of a beveled surface of the adapter.

Turning to Porter, it discloses a toroidal spring (116) disposed between a recess (110) in a dental implant (10’) and a recess (112) in a abutment (90’), for providing a feedback mechanism indicating the proper positioning of the abutment into the dental implant (10’).

The Examiner has relied on Porter for the alleged teaching of “a dental implant (10) that includes an undercut (110) dimensioned suitably for clampingly receiving a clamping ring (116) and wherein the clamping ring allows the clamping portion to connect to the dental implant (Fig. 6D); and wherein the undercut (10) corresponds to the radial groove (112) of the transfer part (64)”. The Examiner has further alleged that it would be obvious for a person of ordinary skill in the art at the time the invention was made to modify Vogt to include an implant having an undercut dimensioned suitably for clampingly receiving a clamping ring, as taught by Porter, in order to provide an anti-rotational locking system where the implants is lockingly secured onto the transfer port of the apparatus. (*see*, Page 4, Paragraph 2 of the Office Action).

Applicants respectfully disagree with the Examiner’s above allegation and reasoning.

First, the functionality and intention of the combination of the toroidal spring, undercut and radial groove offered by Porter is completely different from the claimed invention. The only purpose of the combination is to “provide feedback to the practitioner indicating when the abutment is properly seated” (*see*, Paragraph [0060], Lines 1-2 of Porter). Porter defines this combination a “complementary feedback feature” (*see*, Paragraph [0021]). The combination is not intended for holding the abutment.

Furthermore, Porter teaches the engagement between the dental implant and the abutment. In contrast, the claimed invention is related to the engagement between the dental implant and the transfer part for holding the dental implant. The Examiner has failed to recognize that the abutment of Porter is not a transfer part for holding a dental implant, as defined in the present application and also as well known in the art. The abutment is a structure normally fixed on top of the implant screwed in human tissue (like a jaw bone), for supporting a crown normally made of porcelain; while the transfer part is used for temporarily holding a dental implant and keeping the same in a vial of liquid for a long time reservation. In industry practice, the transfer part is detached from the dental implant for the purpose of planting the dental implant into human tissue. Thus, the abutment (90') of Porter is by no means a disclosure to the transfer part of the claimed invention.

In order to support a finding of obviousness under 35 U.S.C. §103, the Examiner must provide “...some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”. *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 U.S.P.Q.2d 1385, page 1396, (2007).

In the instant case, the Examiner has failed to provide a line of reasoning why a person of ordinary skill in the art would combine the teaching of Porter (directed to the engagement between an abutment and a dental implant) with the teaching of Vogt (directed to the engagement between a transfer part and a dental implant).

In sum, neither Vogt nor Porter, taken alone or in combination, teach or fairly suggest the combination of features recited in independent Claim 11, 17 and 18, from which the other claims ultimately depend. Accordingly, the rejection of claims 11, 13, 14 and 16-21 under 35 U.S.C. §103(a) based on Vogt and Porter is overcome, and withdrawal thereof is respectfully requested.

The Examiner has rejected Claim 12 under 35 U.S.C. §103(a) as allegedly unpatentable over Vogt and Porter, in view of U.S. Patent No. 5,078,605 to Sutter et al., (hereinafter “Sutter”). The rejection is respectfully traversed for at least the reasons set forth below.

Claim 11, from which Claim 12 depends, is discussed above.

Vogt and Porter are discussed above relative to Claim 11. Sutter is applied to allegedly teach the materials, such as PEEK, for making a clamping ring. Without acquiescing to the propriety of the Examiner’s interpretation of Sutter, Applicants respectfully submit that Sutter does not remedy the underlying deficiencies of Vogt and Porter with regard to Claim 11. Thus, taken alone or in any combination, none of Vogt, Porter and Sutter teach or suggest the combination of features recited in Claim 12.

Accordingly, the rejection of Claim 12 under 35 U.S.C. § 103(a) based on the combination of Vogt and Sutter is overcome, and withdrawal thereof is respectfully requested.

In view of the foregoing amendments and remarks, it is firmly believed that the subject application is in condition for allowance, which action is earnestly solicited.

Respectfully submitted,



Peter I. Bernstein
Registration No. 43,497

SCULLY, SCOTT, MURPHY & PRESSER, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
516-742-4343 - Telephone
516-742-4366 - Fax

PIB/HC/ech